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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/615,770 | 07/10/2003 | Satoshi Mochizuki | 240051US2 | 9477 |

22850 7590 09/29/2005

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EXAMINER

NOTE, JANIS L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1756

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/615,770

Applicant(s)

MOCHIZUKI ET AL.

Examiner

Janis L. Dote

Art Unit

1756

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see the attached, paragraph 1. (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1-9, 11-15, 17-20 and 22-29.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attached, paragraph 3.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☒ Other: IDSs filed on 9/15/04; 9/24/04; 6/20/05.

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP ~~1540~~
1700

**Notice of Non-Compliant
Amendment (37 CFR 1.121)**

| | | |
|-----------------|------------------|--|
| Application No. | Applicant(s) | |
| 10/615,770 | MOCHIZUKI ET AL. | |
| Examiner | Art Unit | |
| Janis L. Dote | 1756 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 14 September 2005 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☒ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☒ C. Other see attached paragraph 2.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other _____.
- ☐ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
 - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☐ E. Other: _____.

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted within the time period set forth in the final Office action.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

Failure to timely respond to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Art Unit: 1756

1. The proposed amendments to independent claims 1, 6, 12, and 17 set forth in the amendment filed on Sep. 14, 2005, adding the limitation that the toner has "a particle diameter less than our [sic] to 7 μm ," raise new issues because that limitation was not present in the claims when the final office action was mailed on May 20, 2005.

The proposed amendments to independent claims 1, 6, 12, and 17 set forth in the amendment filed on Sep. 14, 2005, adding the limitation that the toner satisfies the relationship "SF-1 < SF-2," raise new issues because independent claims 1, 6, 12, and 17 and claims dependent on claims 1, 6, 12, and 17, did not recite said limitation at the time the final rejection was mailed. The limitation "SF-1 < SF-2" also raises a rejection under 35 U.S.C. 112, first paragraph, for lack of adequate written description for the reasons discussed in the final office action, paragraph 11, item (4), with respect to independent claims 26-29.

The proposed amendments to dependent claims 22-25 set forth in the amendment filed on Sep. 14, 2005, adding the limitation that the image is a "binarized image" raise new issues because those claims did not require that the image of the inorganic fine particles be a "binarized image."

Art Unit: 1756

2. Notice of NON-COMPLIANT AMENDMENT (37 CFR 1.121)

Item C: The proposed "Amendment to the specification" section filed on Sep. 16, 2005, is not in compliance with 37 CFR 1.121, because the proposed amended paragraphs at pages 106, 108, and 110, attempt to amend paragraphs that are not present in the instant specification.

The proposed amended paragraphs use the term "Bontron E-84." That term was replaced with the term "BONTRON E-84" in the previously filed amended paragraphs in the "Amendment to the specification" section filed on Jan. 10, 2005.

37 CFR 1.121(b)(1)(ii) states that "[t]he full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters" (emphasis added).

3. The examiner's refusal to enter the amendment filed on Sep. 16, 2005, renders applicants' arguments moot regarding said amendment. The rejections of instant claims 1-9, 11-15, 17-20, and 22-29 stand for the reasons discussed in the final rejection mailed on May 20, 2005.

Furthermore, applicants' arguments regarding the rejection of claims 1-9, 11-15, and 17-20, under 35 U.S.C. 112, second paragraph, set forth in the final rejection mailed on May 20,

Art Unit: 1756

2005, paragraph 9, item (1), are not persuasive. As discussed in the rejection, the specification does not define the term "average degree of roundness" recited in instant claims 1-9, 11-15, and 17-20. Contrary to applicants, the meaning the term would not be apparent to a person having ordinary skill in the art from the disclosure at page 36, line 11, to page 37, line 11. That disclosure merely states that the "average degree of roundness" may be determined by the methods disclosed at page 36, line 11, to page 37, line 11. Applicants have not provided any objection evidence showing that the term "average degree of roundness" has a well-known definition in the toner art, e.g., in the form of a standard textbook or a Rule 132 declaration from an expert in the art that provides a well-known definition in the toner art for the term "average degree of roundness." "The meaning of every term used in a claim should be apparent from the prior art or from the specification and drawings at the time the application is filed. Applicants need not confine themselves to the terminology used in the prior art, but are required to make clear and precise the terms that are used to define the invention whereby the metes and bounds of the claimed invention can be ascertained" (emphasis added).

MPEP 21703.05(a).1.

Applicants' arguments regarding the rejection of claim 11

Art Unit: 1756

under 35 U.S.C. 112, first paragraph, set forth in the final rejection mailed on May 20, 2005, paragraph 11, item (1), are not persuasive. The originally filed specification at page 51, line 12, to page 52, line 19, lists a number of particular pigments and dyes that can be used as a toner colorant. The specification further discloses that a mixture of those particular pigments and dyes may be used as a toner colorant. The recitation "plurality of colors" recited in instant claim 11 is broader than the disclosure in the originally filed specification, because it includes "colors" that are not included in the list at page 51, line 12, to page 52, line 19, of the originally filed specification.

Applicants' arguments regarding the rejection of claims 13 and 18 under 35 U.S.C. 112, first paragraph, set forth in the final rejection mailed on May 20, 2005, paragraph 11, item (2), are not persuasive. First, applicants have not indicated by page and line number where the quoted passage is located in the originally filed specification. Second, the hydrophobic silica particles disclosed in the quoted passage do not appear to be the inorganic fine particles recited in instant claims 13 and 18. The quoted passage states that the toner may be "modified by being added and mixed with an inorganic fine particle of the present invention such as an oxide fine

Art Unit: 1756

particle, or a hydrophobic silica fine powder" (emphasis added). Furthermore, even if the hydrophobic silica particles in the quoted passage are the inorganic fine particle recited in instant claims 13 and 18, the passage would not state that the inorganic fine particles "include a silica" as recited in instant claims 13 and 18, but would state that the inorganic fine particles of the invention are hydrophobic silica particles.

Applicants' arguments regarding the rejection of claims 26-29 under 35 U.S.C. 112, first paragraph, set forth in the final rejection mailed on May 20, 2005, paragraph 11, item (4), are not persuasive. Applicants assert that the originally filed specification provides antecedent basis for the limitation "SF-1 < SF-2" because that limitation is satisfied by each of the disclosed embodiments of the specification. However, as discussed in the final rejection, the originally filed specification does not broadly disclose that the parameter factor SF-1 is less than the parameter SF-2. The specification merely discloses that the base toner has a SF-1 value and a SF-2 value that satisfy the relations $105 \leq \text{SF-1} \leq 130$ and $120 \leq \text{SF-2} \leq 180$. There is no disclosure in the specification that the SF-1 value has to be less than the SF-2 value. The examples of the originally filed specification only provide

Art Unit: 1756

antecedent basis for those particular toners exemplified in the examples. Furthermore, even comparative examples 1 and 2 comprise toners that satisfy the relationship $SF-1 < SF-2$. See Toners 2 and 6 at pages 111 and 112. Toners 2 and 6 do not have a SF-1 value and a SF-2 value that satisfy the relations $105 \leq SF-1 \leq 130$ and $120 \leq SF-2 \leq 180$. The examples do not provide an adequate written description for the toner broadly recited in instant claims 26-29.

4. The examiner has crossed out the US applications 10/876,718 and 10/875,402 listed on "List of Related Cases" filed in the Information Disclosure Statement (IDS) filed on Jun. 20, 2005, after the final rejection mailed on May 20, 2005, because the US published applications of said US applications, US 2005/0003288 and US 2005/0026064, were listed on the form PTO-1449 filed on Jun. 20, 2005. The US published applications US 2005/0003288 and US 2005/0026064 have been considered. The US applications 10/876,718 and 10/875,402 were previously listed in the IDS's previously filed on Sep. 15, 2004, and on Sep. 24, 2005. Those IDS's failed to comply with the requirements of 37 CFR 1.98(b) for the reasons discussed in the final rejection mailed on May 20, 2005, paragraph 3. Applicants were given ONE month from

Art Unit: 1756

the mail date of the final rejection mailed on May 20, 2005, to supply the missing copies of those US applications.

The examiner has also crossed out the US applications 09/864,596 and 10/032,172 listed in the "List of related cases" and the US published applications of said applications, US 2001/0044059 and US 2002/0098436, respectively, which are listed on the form PTO-1449 filed in the IDS on Jun. 20, 2005, because the listing of those US applications and the form PTO-1449 listing of the US published applications were filed after the mail date of the final rejection. The listings lacked a statement as specified in 37 CFR 1.97(e) and the fee set forth in 37 CFR 1.17(p). The listing of those US applications and the form PTO-1449 listing of those US published applications have been placed in the application file, but the information referred to therein has not been considered.

US applications 09/864,596 and 10/032,172 were previously listed in the IDS filed on Dec. 4, 2003. The office action mailed on Sep. 9, 2004, paragraph 2, previously gave applicants ONE MONTH from the mail date of that office action to supply the copies of those portions, i.e., the originally filed claims and drawings, of those applications that caused them to be listed in the IDS of Dec. 4, 2003. However, applicants failed to do so in the IDS filed on Oct. 12, 2004, and in the IDS filed on Nov. 1,

Art Unit: 1756

2004. The final rejection mailed on May 20, 2005, paragraph 3, gave applicants ONE MONTH from the mail date of the final rejection to supply only the missing portions of the IDS's filed on Sep. 15, 2004, and Sep. 24, 2004. The final rejection did not give applicants another month to supply the missing portions of the IDS filed on Dec. 4, 2003.